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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,749	07/28/2003	Philip G. Wessells	20003-7003	4857
35939	7590	07/02/2004	EXAMINER	
MICHAEL E. WOODS PATENT LAW OFFICES OF MICHEAL E. WOODS 112 BARN ROAD TIBURON, CA 94920-2602			COLILLA, DANIEL JAMES	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/628,749

Applicant(s)

WESSELLS, PHILIP G.

Examiner

Dan Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 7-12 and 15-19 is/are rejected.
7) ☒ Claim(s) 5, 6, 13 and 14 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore;

- the cartridge (as recited in claim 5),
- the plurality of pads having different cross-sectional areas (as recited in claim 6),
- the plurality of media of transfer media secured using an adhesive disposed between successive edges (as recited in claim 9),
- the plurality of media of transfer media secured using an adhesive adhered to a plurality of side edges (as recited in claim 10),
- the aperture in the transfer engine (as recited in claim 12),
- the mechanism which ejects the removed transfer medium (as recited in claim 14), and
- the transfer media being detached from said pad (as recited in claim 18)

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The

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replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 4 and 15 are objected to because of the following informalities:

In claim 15, the phrase, "wherein said transfer image is a printer" does not appear to make sense. Perhaps applicant intended to recite --transfer engine--.

In claim 4, line 2, it appears that "include" should actually be --includes--.

Appropriate correction is required.

3. Claims 7-10 and 14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 7-10 are directed towards an image transfer apparatus but recite no structure to further limit the image transfer apparatus. Instead applicant has recited limitations of the transfer medium. The transfer medium is not considered part of the invention since it is recited in a "for use" statement. Statements of intended use are not given any patentable weight in an apparatus claim.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 2 applicant recites that the transfer engine includes an electrostatic transfer system. However, no support for this type of system can be found in the specification.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 7-10 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Saka (JP 09-058073).

With respect to claim 1, Saka discloses in image transfer apparatus including a housing 1, a transfer engine 214 within the housing and a transfer medium registration system 400,401,304.

With respect to claim 3, Saka discloses that the transfer engine 214 is an ink ejection system as disclosed in paragraph [0017], lines 1-2 of the machine translation of Saka.

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With respect to claims 7-8, applicant has not recited any further structure in this claim with respect to the image transfer apparatus, therefore these claims are rejected along with their parent claim.

Similarly, claims 9-10 are rejected along with their parent claim because no further structure of the image transfer apparatus is recited.

With respect to claim 15, Saka discloses that the image transfer apparatus is a printer since it uses an ink jet printhead 214.

With respect to claim 16, Saka discloses a transferring method including the step of positioning a pad 10 at a transfer position (shown as hidden lines in Figure 4 of Saka, see paragraph [0025] of the machine translation of Saka). In paragraph [0026] of the machine translation, Saka discloses transferring an image to one of the transfer media positioned in the transfer position.

With respect to claim 17, in paragraph [0010] of the machine translation, Saka discloses that the transfer media is comprised of a series of sheets 12 that are removably adhered to one another to form a pad 10.

With respect to claim 18, in paragraph [0028] of the machine translation, Saka discloses removing a printed sheet 12 from the pad 10 when the printing has been completed.

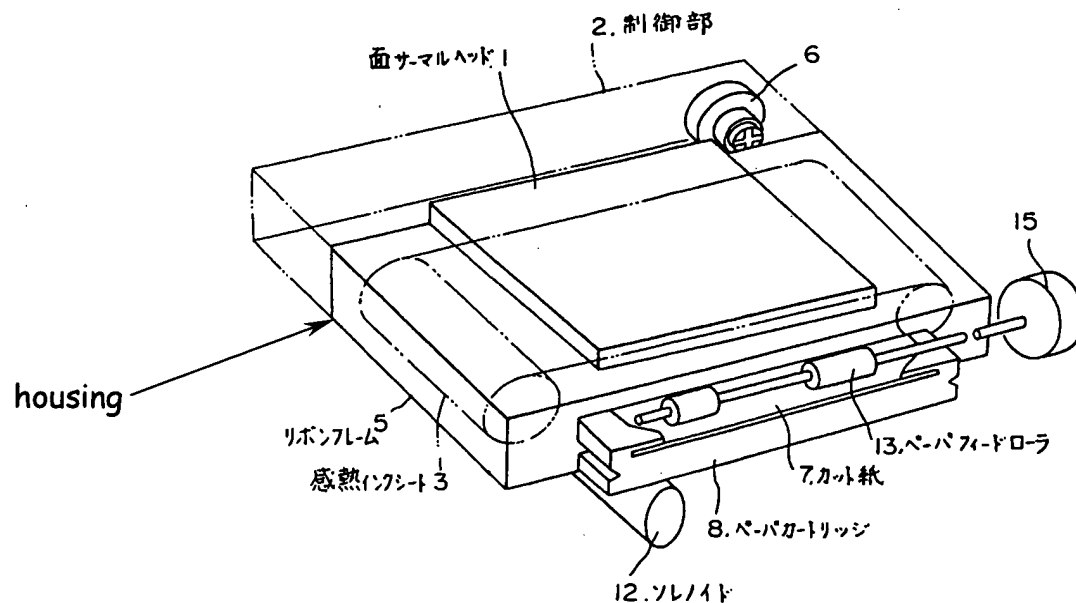
With respect to claim 19, Saka discloses an image transfer apparatus including a means 400,401,304 for positioning a pad 10 at a transfer position (as shown in Figure 4 by the hidden lines) of a transfer engine 1; the pad 10 including a plurality of transfer media 12 removably adhered to one another as disclosed in paragraph [0010] of Saka. Further disclosed by Saka is a

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means 214 for transferring an image to a sheet of transfer media 12. The means 214 for transferring is coupled to the positioning means by the housing of the transfer engine.

8. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Isobe (JP 61-095962).

Isobe discloses an image transfer apparatus including a housing as shown below taken from Figure 2 of Isobe:



—337—

a transfer engine 1a (as shown in Figure 1 of Isobe) and a transfer medium registration system 8,9 coupled to the transfer engine through the housing. *Note: "for use" statements are not given any patentable weight.*

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saka (JP 09-058073) as applied to claims 1, 3, 7-10 and 15-19 above, and further in view of Koeda (US 2002/0130925).

Saka discloses the claimed image transfer apparatus except that it is not known what type of ink jet printer is used. However, Koeda teaches an apparatus with an electrostatic ink jet head. It would have been obvious to combine the teaching of Koeda with the image transfer apparatus disclosed by Saka because the manufacture of the ink jet head taught by Koeda uses a substrate low in cost, easy to handle and large in size can be used to improve the productivity in the manufacture of the head (Koeda, paragraph [0006]).

11. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saka (JP 09-058073) as applied to claims 1, 3, 7-10 and 15-19 above, and further in view of Hayao et al. (JP 2000-301775).

With respect to claim 11, Saka discloses the claimed image transfer apparatus except for the replaceable cartridge. However, Hayao et al. discloses an image transfer apparatus with a replaceable ink cartridge 4 as shown in Figure 1 of Hayao et al. It would have been obvious to

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combine the teaching of Hayao et al. with the image transfer apparatus disclosed by Saka for the convenience of easily adding new ink when the apparatus runs out.

With respect to claim 12, an ink jet printhead, such as printhead 214 disclosed by Saka inherently has an aperture for ejecting ink since this is how the ink leaves the printhead to land on the paper. The cartridge 4 disclosed by Hayao et al. contains ink as mentioned above.

Allowable Subject Matter

12. Claims 5-6 and 13-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter:

Claims 5-6 have been indicated as containing allowable subject matter primarily for the cartridge for storing the pad.

Claims 13-14 have been indicated as containing allowable subject matter primarily for the media stripper.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 30, 2004



Daniel J. Colilla
Primary Examiner
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